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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,868	11/26/2002	Xue Mei Zhou	3291.3B	5269

22886 7590 10/19/2005

AFFYMETRIX, INC  
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EXAMINER

MILLER, MARINA I

ART UNIT PAPER NUMBER

1631

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/065,868

Applicant(s)

ZHOU ET AL.

Examiner

Marina Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17,19-31,33-35 and 84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-17,19-31,33-35 and 84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/11/05;12/17/03.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 1 copy.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' submission filed on 8/11/2005 is acknowledged. Claims 1-2, 4-17, 19-31, 33-35, and 84 are pending. Claims 3, 18, 32, and 36-83 are cancelled. Claims 1-2, 4-17, 19-31, 33-35, and 84 presently are under examination.

Applicants' arguments have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are applied.

#### ***Priority***

Applicant's claim for priority under 35 U.S.C. 119(e), 120, and 122 is acknowledged. However, the applications for which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-2, 4-17, 19-31, 33-35, and 84 of the instant application, as set forth in the previous office action mailed 2/11/2005.

As support for the elected claims is not found in the priority applications, priority for the elected claims is granted only to the filing date of the instant application of 11/26/2002.

#### ***Information Disclosure Statement***

The information disclosure statement ("IDS") filed 8/11/2005 has been considered. Examiner appreciates applicants' indicating that US 2004/067488 is an English language translation of WO 02/061646A1 listed on the IDS filed 12/17/2003. In view of this, the examiner initialed WO 02/061646A1 publication on the IDS filed 12/17/2003. References that were considered in the previous office action mailed 2/10/2004 or in the instant office action have been crossed out to avoid duplication upon printing.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4-17, 19-31, 33-35, and 84 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claims 1-2, 4-17, 19-31, 33-35, and 84 were rejected under 35 U.S.C. 101 in the previous office action mailed 2/10/2005 for lack of patentable utility. Applicants did not address the lack of patentable utility rejection in their answer filed 8/11/2005, but instead put forward arguments intended to establish that the rejected claims are directed to statutory subject matter under 35 U.S.C. 101 (*see* page 19 of the applicants' response filed 8/8/2005). However, claims 1-2, 4-17, 19-31, 33-35, and 84 were not rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Also, the amendment filed by applicants does not, *per se*, place the rejected claims in compliance with the utility requirement under 35 U.S.C. 101.

Examiner reiterates that although the claimed invention MAY have a substantial utility because arrays are generally used for studying genetic characteristics and detecting diseases, the invention does not have a specific utility. For example, the result of the claimed method is providing a probe array which is determined on the basis of unknown probe set identifiers. In order for the result to be used for diagnostic purposes, one skilled in the art must be aware of a correlation between the information received from the method and a disease, disorder, trait, or condition to be diagnosed. Absent any disclosure about, for example, the connection of the array to a particular state, disease, trait, *etc.*, the asserted utility is not specific. No such information is recited in the instant claims. Thus, for the reasons stated in the previous office action, the

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rejection of claims 1-2, 4-17, 19-31, 33-35, and 84 under 35 U.S.C. 101 is maintained for lack of patentable utility.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 4-17, 19-31, 33-35, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, WO 01/80155, in view of Kincaid, US 2003/0162183.

Anderson makes obvious the method of claims 1-2, 4-17, 19-31, 33-35, and 84, as set forth in the previous office action mailed 2/10/2005.

Although Anderson discloses receiving a user selection of probe set identifiers via a network, he does not specifically disclose indication from a user to share a custom probe assay design.

Kincaid discloses an array design method that allows sharing of array design parameter information between commercial array users [0005]. Specifically, Kincaid discloses that a user can select stored, previously determined probe sequences, and therefore a probe selection would involve a lookup process rather than computation [0099]. Thus, a user who uses predetermined probes “indicates” that he is willing to share a probe design.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify a method of Anderson to share a probe design, such as taught by Kincaid, where the motivation would have been to simplify array design, as taught by Kincaid [0005].

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Claims 1, 5-8, 11-13, 15-17, 19-22, 25-27, 29-31, 33-35, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tekagawa, WO 02/61646, in view of Kincaid, US 2003/0162183.

Takagawa makes obvious the method of claims 1, 5-8, 11-13, 15-17, 19-22, 25-27, 29-31, 33-35, and 84, as set forth in the previous office action mailed 2/10/2005.

Although Tekagawa discloses receiving a user selection of probe set identifiers via a network, he does not specifically disclose indication from a user to share a custom probe assay design.

Kincaid discloses an array design method that allows sharing of array design parameter information between commercial array users [0005]. Specifically, Kincaid discloses that a user can select stored, previously determined probe sequences, and therefore a probe selection would involve a lookup process rather than computation [0099]. Thus, a user who uses predetermined probes “indicates” that he is willing to share a probe design.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify a method of Takagawa to share a probe design, such as taught by Kincaid, where the motivation would have been to simplify array design, as taught by Kincaid [0005].

Claims 2, 4, 14, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tekagawa, WO 02/61646, in view of Cantor, U.S. Patent 6,007,987, and further in view of Kincaid, US 2003/0162183.

Tekagawa and Cantor make obvious the method of claims 2, 4, 14, and 28, as set forth in the previous office action mailed 2/10/2005.

Tekagawa and Cantor do not specifically disclose indication from a user to share a custom probe assay design.

Kincaid discloses an array design method that allows sharing of array design parameter information between commercial array users [0005]. Specifically, Kincaid discloses that a user can select stored, previously determined probe sequences, and therefore a probe selection would involve a lookup process rather than computation [0099]. Thus, a user who uses predetermined probes “indicates” that he is willing to share a probe design.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify a method of Takagawa and Cantor to share a probe design, such as taught by Kincaid, where the motivation would have been to simplify array design, as taught by Kincaid [0005].

Claims 8-10 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tekagawa, WO 02/61646, in view of Garner, U.S. 2003/0033290, and further in view of Kincaid, US 2003/0162183.

Tekagawa and Garner make obvious the method of claims 8-10 and 22-24, as set forth in the previous office action mailed 2/10/2005.

Tekagawa and Garner do not specifically disclose indication from a user to share a custom probe assay design.

Kincaid discloses an array design method that allows sharing of array design parameter information between commercial array users [0005]. Specifically, Kincaid discloses that a user can select stored, previously determined probe sequences, and therefore a probe selection would

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involve a lookup process rather than computation [0099]. Thus, a user who uses predetermined probes “indicates” that he is willing to share a probe design.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify a method of Takagawa and Garner to share a probe design, such as taught by Kincaid, where the motivation would have been to simplify array design, as taught by Kincaid [0005].

### *Conclusion*

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Miller whose telephone number is (571)272-6101. The examiner can normally be reached on 8-5, M-F.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph. D. can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Miller  
Examiner  
Art Unit 1631

MM

**MARJORIE A. MORAN**  
**PRIMARY EXAMINER**

*Marjorie A. Moran*  
*10/12/05*